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EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 07/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



Applicant's amendment of 5/5/05 has been entered. The examiner will address applicant's remarks at the end of this office action.

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

With respect to claims 1-10, applicant has claimed a data source and various modules that perform various functions, or the means language for claims 6-10. In the specification on page 8, applicant has stated that the modules may be computer programming or may "include human participation" in performing the functions. Based on this disclosure, the examiner has concluded that the claims are directed to non-statutory subject matter because the claimed "data source" can be a human and the modules recited in the claims include humans as well. Because the specification discloses that the modules may include humans to perform the steps, the recited modules (or means limitations) then include humans in their scope, which renders the claims as non-statutory.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. Claims 2,7, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

For claims 2,7,17, applicant has claimed various modules that perform various functions, such as a module to generate financial data. Also claimed is a module that determines service and support resources. The examiner has consulted the specification for guidance on how one of skill in the art would go about performing these functions and finds that there is very little guidance on how this is done. What is the financial data that is recited in this claim and how exactly is it generated? It is not clear at all as to how this is done. The fourth module somehow determines service and support resources, but upon reading the specification, one of skill in the art would not know how this determination is performed. The examiner feels that applicant has more or less set forth some basic concepts of what is to be done, but there is not enough guidance in the specification to allow one of skill in the art to practice the invention as claimed. What factors are taken into account for each module and how are the results accomplished? How does the third module generate financial data and what exactly is the financial data? It is not clear what this means or how this is accomplished. The determination of serve and support resources is done how? Once you obtain some data on the predicted failures of products and the timing of the failures, how does this system figure out what resources are needed? Not much at all is disclosed with respect

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to this module. Overall the examiner feels that one of skill in the art would have to practice undue experimentation to figure out how to set up each module so that the recited results can be obtained. The claim is not enabled.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-10,16-20, are rejected under 35 U.S.C. 102(e) as being anticipated by Aragones et al. (6832205).

Aragones discloses a system and method by which product failure data is analyzed with respect to "service contracts" (i.e. warranties) so that the costs associated with the products and the contracts can be analyzed and the results obtained will allow one to forecast future events related to the servicing of the product and what resources may be needed in the future.

For claims 1,6,16,18-20, Aragones discloses a data source 30 that contains raw data as claimed. The 1<sup>st</sup> and 2<sup>nd</sup> modules are interpreted to be portions (subroutines) of the analyzer 34 that performs the recited functions. See column 2, lines 10-14 and figure 3. For claim 6, the means for receiving data is the data bus 16 or other data input

hardware of Aragon. This allows data to be received. The means for generating failure data and cost data is analyzer 34 that performs the recited functions.

For claims 2,7,17, as best understood by the examiner, the 3<sup>rd</sup> module is considered to be portions (subroutines) of the simulator 44 that performs the recited function. The 4<sup>th</sup> module is satisfied by what is disclosed in column 6, lines 49-57, where the service and support resources are disclosed as being determined. The means for analyzing a change based on alternative data is the analyzer 34. All one has to do is enter new data and see what results the analyzer comes up with. The means for analyzing is the ability to enter new data, which Aragon inherently has.

For claims 3,8, as best understood by the examiner, Aragon inherently is configured to monitor cost data and the resulting data that is output will indicate whether or not it is above some threshold value. Aragon is analyzing the same kind of data to determine predicted failures and the servicing costs associated with those failures and this satisfies what has been claimed.

For claims 4,5,9,10, these claims are directed to non-functional descriptive material. The data that the system is intended to use does not constitute a part of the system and reciting the kind of data that the system uses is not a further recitation to any further structure. However, Aragon discloses that data such as claimed is taken into account in the analysis of product failure and the associated "service contract" costs.

7. Applicant's arguments filed 5/5/06 have been fully considered but they are not persuasive.

With respect to the 101 rejection, applicant has stated that the amendment overcomes the rejection. The examiner disagrees and does not understand how the changing of the preamble to recite "A computer implemented..." changes anything. The position of the examiner and the reason for the 101 rejection remain the same. The amendment is not considered sufficient to overcome the rejection.

With respect to the 112,<sup>1st</sup> rejection, the portions of the specification that applicant referred the examiner to do not provide enablement for the claimed invention. Applicant stated that page 8 to page 11 teaches how the financial data is created. Pages 8 to 11 mention nothing about financial data. Pages 8 to 11 discuss the fact that data is taken into account, but there is no discussion as to how and nothing is mentioned about the generation of financial data. Pages 8 to 11 discuss data such as customer service data and the dates of their occurrence, and data such as the timing of the event. These are not examples of financial data. Other data discussed is data about events for which no failure occurred, but where some sort of service was required. This is not financial data. Data about when each item was shipped is also discussed, but this is not financial data either. The examiner has read the cited portions of the specification but does not see how these portions relate to the generation of financial data as the claims recite. The argument is non-persuasive.

Concerning the 112,<sup>1st</sup> rejection for the limitation of the determination of service and support resources, the applicant has directed the examiner to claims for a showing

of enablement. This is not a persuasive argument because it is the specification itself that must provide the enabling disclosure and the claims themselves are not teaching how these recited functions are being performed. The portions of the specification cited have been reviewed, but are not found to be enabling. The cited portions do not discuss how to go about performing the claimed steps. The argument is non-persuasive.

Concerning the 102 rejection, applicant's sole argument is that the service contract of Aragones cannot be considered equivalent to a warranty. The examiner disagrees and points out that Aragones is doing the same steps as recited in the claims. The fact that the claims use the adjective "warranty" to describe the kind of data that is generated and used is not sufficient to define over the prior art. A service contract is a form of a warranty. When you purchase a new automobile and purchase an extended warranty, this is the equivalent to a service contract. They are the same thing as far as the examiner is concerned. You pay for an extended warranty and in return you get a guarantee that the product is covered if repair or replacement of certain parts is required due to a failure. The sole argument is non-persuasive.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the



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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
DENNIS RUHL  
PRIMARY EXAMINER